REMARKS/ARGUMENTS

Claims 1-7 and 17-23 are pending. Claims 8-16 have been canceled due to a restriction requirement, however, Applicant reserves all right to pursue these or other claims in a continuing application. Claims 17-23 have been added in this amendment and Applicant requests consideration of these new claims. In light of the amendment and following remarks, Applicant believes the application is in condition for allowance.

Applicant filed a Request for Reconsideration on May 20, 2004. Applicant telephoned the Examiner on July 20, 2004 and was informed the Request was not on the PTO system as ever being received. Accordingly, Applicant has included the substance of that Request in this amendment.

The § 103(a) Rejection of Claims 1-7

Claims 1-7 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,832,431, issued November 3, 1998 to Sheffield in view of U.S. Patent No. 5,907,847, issued May 25, 1999 to Goldberg and further in view of U.S. Patent No. 6,108,004, issued August 22, 2000 to Medl. For the following reasons, Applicant respectfully traverses the rejection.

A prima facie case of obviousness requires, among other things, a showing that the cited art teach or suggest all the limitations in the claims. The Office Actions simply have not shown this. For example, the latest Office Action stated as follows:

> Examiner asserts that while the lines in question do state that the source code is generated by a user, the executable code (Java bye code) is generated automatically by the Java VM or compiler.

(page 5, emphasis in original). Thus, the Examiner admits that the references teach that a user first generates source code and then a software application turns the user-written source code into executable code. This is not what is recited in the claims.

With the claimed invention, a user specifies desired data elements to be extracted from an operational database. Then, executable code is generated from the specified data elements. Claim 1 recites this as follows:

> specifying desired data elements to be extracted from an operational database;
>
> automatically generating executable code from said specified data elements, the generated code being for extracting said specified data elements from said operational database;

(emphasis supplied). As the claim clearly recites, data elements to be extracted are specified and executable code is generated from the specified data elements – not from source code as is alleged is in the cited art.

With regard to the specifying step, the Office Actions cite Sheffield asserting that the reference shows how one can use a GUI to specify desired data elements (Office Action mailed August 12, 2003, page 4). Then, the Office Action cites Goldberg for generating executable code from user-written source code. As shown above, the Examiner acknowledges that Goldberg teaches a user writing source code and a software application generating executable code from the user-written source code. This demonstrates a prima facie case of obviousness has not been established since it has not been shown where any cited reference teaches generating executable code from specified data elements as claimed.

The Office Actions then attempt to show why someone of ordinary skill in the art at the time of the invention would be motivated to modify the cited art in order to achieve the claimed invention. Three theories are cited as follows (see Office Action mailed August 12, 2003, pages 6-7):

"a) so that the state and behavior of the object are stored reliably in the Database Management System (DBMS) in a single location such that a modification can be made to both state and behavior in one transaction;" Goldberg specifically teaches that an object's definition can be stored in the DBMS in order to reliably store the state and behavior of an object (col. 6, lines 6-10). Goldberg also states that this allows modifications to both state and behavior to be made in one transaction. Thus, the Examiner's alleged motivation to modify the references is already provided by Goldberg alone. Accordingly, this does not provide a motivation to modify the references.

"b) so that when an object is extracted or replicated both its state and its behavior can be transferred securely and reliably;" Goldberg teaches that because the state and behavior of an object can be stored in one location (e.g., the DBMS), both the state and its behavior can be operated on in a single transaction (see col. 6, lines 7-10). Once again, the Examiner's alleged motivation to modify the references is already provided by Goldberg alone. Accordingly, this does not provide a motivation to modify the references.

"c) so that platform independent code can be generated from the object itself without additional modification when the object is extracted and stored in another environment (as taught by Goldberg at Col. 6, lines 6-13; Col. 7, lines 33-48)." Again, the Examiner is citing advantages that are alleged to be already provided by Goldberg. As Goldberg already purports to provide these advantages, it is not a motivation to modify the references.

A prima facie case requires, among other things, that a suggestion or motivation be shown to modify or combine the cited art. Here, the Examiner has cited three advantages that are explicitly already provided by a single reference Goldberg. This does not provide any motivation to modify or combine this reference. In fact, it would seem to only illustrate a motivation to use the teachings of the reference, which by themselves are admitted in the Office Actions to be deficient in teaching all the limitations of the claims.

As the Office Actions have not shown where the cited art teaches generating executable code from specified data elements, a prima facie case of obviousness has not been established. Also, there has been no showing of a suggestion or motivation to modify or combine the references as also required to establish a prima facie case of obviousness. Accordingly, the claims are patentably distinct over the cited art.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (408) 446-8693.

Respectfully submitted,

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